UNITED STATES
PATENT AND
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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Application of :
Alan N. Houghton et al :
Serial No.: 09/627,694 : PETITION DECISION
Filed: July 28, 2000 :
Attorney Docket No.: MSKP026US2 :

This is in response to applicants' petition under 37 CFR 1.144, filed July 25, 2001, requesting review and modification of the restriction requirement set forth by the examiner.

A review of the file history shows that this application was filed under 35 U.S.C. 111 on July 28, 2000, and is a continuation-in-part of SN 09/308,697, filed May 21, 1999, which is the national phase entry of PCT/US97/22669, filed December 10, 1997, which claims benefit of Provisional applications SN 60/036,419, filed February 18, 1997, SN 60/032,535, filed December 10, 1996, and SN 60/180,651, filed January 26, 2000. The application, as filed, contains claims 1-39. The examiner set forth in a first Office action, mailed March 1, 2001, a restriction requirement under 35 U.S.C. 121 of the claims as follows:

> Group I - claims 1-21 drawn to a method of stimulating an immune response by administering an antigen;
> Group II - claims 22-23, drawn to stimulating an immune response by administering blood or bone marrow-derived cells;
> Group III - claims 24-28, drawn to a method of stimulating an immune response by administering a mutant form of an antigen;
> Group IV - claims 29-32 and 33, drawn to a non-human cell line expressing human antigen gp75;
> Group V - claims 29-32 and 34, drawn to a non-human cell line expressing human antigen gp100;
> Group VI - claims 29-32 and 35, drawn to a non-human cell line expressing human antigen TRP-2;
> Group VII - claims 29-30 and 36-37, drawn to a non-human cell line expressing human antigen that is prostate specific;
> Group VIII - claims 38-39, drawn to an expression vector comprising a DNA sequence.

The examiner reasoned that Groups I-III differ in their method steps and objectives and are therefor different methods. Groups IV-VIII are considered to be structurally different products made by different methods and having different uses. Groups I and IV-V are related as products and process of use and are distinct since either product can be used in the method. Groups II and

VI-VII are related as product and process of use and are likewise distinct for the same reasons as above. Groups III and IV-VIII are also related as products and process of use and are distinct for the same reasons as above.

Applicants replied on April 4, 2001, adding claim 40 to a tyrosinase antigen and electing group IV for prosecution with traverse. Applicants argued that Groups IV-VII should not be characterized as separate inventions, but a genus and species and subject to an election of species and that the claim to tyrosinase should be considered an additional species. Applicants argued that the method claims should be considered with the product claims or that if the product claims are found allowable, the method claims should be rejoined with the product claims. Applicants also argued that Group VIII sufficiently overlaps the elected Group claims that no additional burden is placed upon the Office for examination. The examiner mailed a new Office action to applicants on May 16, 2001, maintaining the requirement based on the argument that the specified antigens are patentably distinct and that the search, especially of the literature, is not coextensive and made the requirement final. However the examiner did acknowledge that method claims limited to the scope of allowable product claims would be rejoined at the time the product claims are found allowable. The examiner rejected the elected claims under 35 U.S.C. 112, second paragraph, as indefinite, and under 35 U.S.C. 103(a) as obvious. This petition followed on July 18, 2001. A reply to the Office action was filed August 6, 2001.

DISCUSSION

Applicants argue in their petition that Groups IV-VII should not be characterized as separate inventions, but should be the subject of a species election in accordance with 37 CFR 1.146 based on the examiner's inclusion of claims 29-32 in each of the groups, thereby characterizing them as generic claims. Applicants consider claims 29-30 as generic with the elected species being gp75 with claims 34-37 and 40 being recombined if the generic claims are found allowable. Applicants also argue that claims 1-5 and 38-39 should be properly considered with the elected claims, claims 1-2 being generic to the method of stimulating an immune response. Applicants request that the examiner advise them as to whether rejoinder would be considered on allowance of a product claim. Applicants also argue with respect to Group VIII that the subject matter of these claims - an expression vector - overlaps significantly with the elected claims that no significant search burden is presented.

With respect to rejoinder of the method claims with the product claims, the examiner stated in the last Office action (paragraph spanning pages 2-3) that rejoineder would be permitted upon allowance of a product claim. No further action need be taken on this request at this time as no product claims have been allowed. With respect to the generic claims 29-30, these are considered to link patentably different and distinct antigens. The examiner has followed the practice in M.P.E.P. 809 with respect to generic linking claims of this nature and set forth a proper restriction requirement including within each group the generic as well as the species claims. Should the elected product claim be found allowable and the generic claim also be found allowable, consideration will be given to withdrawing the requirement. However the elected species claims, as well as the generic claims, have not been found allowable. Therefor there is no reason to disturb the examiner's requirement at this time. With respect to claims 38-39 (Group VIII), no error is seen in the examiner's requirement for restriction or reasons therefor. Vectors

are not the same as antigens and the search and examination for them would be significantly different than for the antigen alone. The examiner has expressed proper reasoning for arriving at the conclusion that they are separate inventions and that the burden on the Office would be excessive to examine these claims with the elected claims.

DECISION

Applicants' petition is **DENIED** for the reasons set forth above.

The application will be forwarded to the examiner for consideration of the reply filed August 6, 2001.

Any request for reconsideration or review of this decision must be by way of a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600/2900, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

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